

02-12-07

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PTO/SB/21 (6/98)

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# TRANSMITTAL FORM

(To be used for all correspondence after initial filing)

|                      |                    |
|----------------------|--------------------|
| Application No.      | 10/667,115         |
| Filing Date          | September 19, 2003 |
| First Named Inventor | Russell N. Mirov   |
| Group Art Unit       | 2841               |
| Examiner Name        | Dinh, Tuan T.      |
| Attorney Docket No.  | SUN03-0112         |

Total Number of Pages in this Submission:

**ENCLOSURES (check all that apply)**

|  |   |  |
|--|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input checked="" type="checkbox"/> Fee attached<br><input type="checkbox"/> Amendment/Response<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavit/Declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts Notice/Incomplete Application<br><input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers for an application<br><input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input checked="" type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney by Assignee, with Revocation of Former Powers<br><input type="checkbox"/> Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Small Entity Statement<br><input type="checkbox"/> Request for Refund | <input type="checkbox"/> After-Allowance Communication to Group<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Additional Enclosure(s):<br><input checked="" type="checkbox"/> Return Receipt Postcard<br><input checked="" type="checkbox"/> Check for \$ <u>200</u><br><input type="checkbox"/> _____ |
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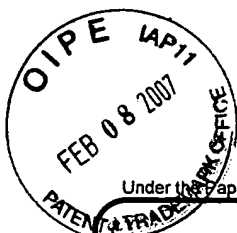
**SIGNATURE OF APPLICANT, ATTORNEY OR AGENT**

|           |   |           |                  |
|-----------|---|-----------|------------------|
| Name      | Daniel E. Vaughan (Registration No. 42,199) | Date      | February 8, 2007 |
| Signature |   | Telephone | 510-790-9960     |
| Address   | P.O. Box 7865, Fremont, CA 94538            | Facsimile | 510-790-9964     |

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# FEE TRANSMITTAL

## For FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 200

### Complete if Known

|                      |                      |
|----------------------|----------------------|
| Application Number   | 10/667,115           |
| Filing Date          | September 19, 2003   |
| First Named Inventor | Russell Norman Mirov |
| Examiner Name        | Dinh, Tuan T         |
| Art Unit             | 2841                 |
| Attorney Docket No.  | SUN03-0112           |

### METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 50-1801 Deposit Account Name: Park, Vaughan & Fleming

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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### FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

#### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES |                       | SEARCH FEES |                       | EXAMINATION FEES |                       | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
|                  | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)         | Small Entity Fee (\$) |                |
| Utility          | 300         | 150                   | 500         | 250                   | 200              | 100                   |                |
| Design           | 200         | 100                   | 100         | 50                    | 130              | 65                    |                |
| Plant            | 200         | 100                   | 300         | 150                   | 160              | 80                    |                |
| Reissue          | 300         | 150                   | 500         | 250                   | 600              | 300                   |                |
| Provisional      | 200         | 100                   | 0           | 0                     | 0                | 0                     |                |

#### 2. EXCESS CLAIM FEES

##### Fee Description

Each claim over 20 (including Reissues)

| Fee (\$) | Small Entity Fee (\$) |
|----------|-----------------------|
| 50       | 25                    |

Each independent claim over 3 (including Reissues)

|     |     |
|-----|-----|
| 200 | 100 |
|-----|-----|

Multiple dependent claims

|     |     |
|-----|-----|
| 360 | 180 |
|-----|-----|

| Total Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
|--------------|--------------|----------|---------------|
|--------------|--------------|----------|---------------|

- 20 or HP =            x            =           

HP = highest number of total claims paid for, if greater than 20.

| Indep. Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
|---------------|--------------|----------|---------------|
|---------------|--------------|----------|---------------|

- 3 or HP =            x            =           

HP = highest number of independent claims paid for, if greater than 3.

#### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets              | Extra Sheets             | Number of each additional 50 or fraction thereof | Fee (\$)            | Fee Paid (\$) |
|---------------------------|--------------------------|--|---------------------|---------------|
| - 100 = <u>          </u> | / 50 = <u>          </u> | (round up to a whole number) x <u>          </u> | = <u>          </u> |               |

#### 4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Fees Paid (\$)

Other (e.g., late filing surcharge): Petition

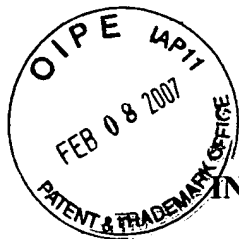
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#### SUBMITTED BY

|                   |                          |  |                        |
|-------------------|--------------------------|--|------------------------|
| Signature         | <u>Daniel E. Vaughan</u> | Registration No. (Attorney/Agent) 42,199 | Telephone 510-790-9960 |
| Name (Print/Type) | Daniel E. Vaughan        |  | Date February 8, 2007  |

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor : Russell Norman Mirov  
Application No. : 10/667,115  
Confirmation No. : 8531  
Filed : September 19, 2003  
Docket : SUN03-0112  
Title : Mechanism for Disabling an Electronic Assembly  
Group/Art Unit : 2841  
Examiner : Tuan T Dinh

**PETITION FOR RECONSIDERATION OF  
RESTRICTION REQUIREMENT AND  
ELECTION OF SPECIES REQUIREMENT**

Mailstop: Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a petition for reconsideration of the restriction requirement and election of species requirement levied in the subject application, in accordance with 37 CFR §§ 1.181, 1.144, 1.113(a). To the extent that neither of Applicant's Replies filed October 7, 2005 and March 14, 2006 are interpreted as a request for reconsideration of these requirements (37 CFR §§ 1.143, 1.144), Applicant also requests this petition be treated as a request for reconsideration.

Due to the manner and extent to which claims were unduly and unnecessarily withdrawn, cancelled or amended, Applicant requests examination of the present application be restarted with all original claims – thereby returning the application to its status prior to the restriction requirement and election of species requirement.

In the alternative, Applicant requests examination of all claims previously or presently presented that read on an elected Invention and Specie.

Because this Petition does not toll the period for reply to the outstanding final office action (mailed November 14, 2006), a Request for Continued Examination is concurrently being submitted for this application.

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## **I STATEMENT OF FACTS**

A. In an office action mailed October 3, 2005, a restriction requirement and an election of species requirement were issued. Regarding the restriction requirement, election was required between Invention I (claims 1-26) and Invention II (claims 27-33), which were characterized as being directed to a product made and a process of making, respectively (MPEP § 806.05(f)). Regarding the election of species requirement, Species I – IV were identified and characterized as being defined by Figures 1 – 4, respectively.

B. In a reply dated October 7, 2005, Applicant traversed the restriction requirement and the election of species requirement, but provisionally elected Invention I and Specie I.

C. On December 27, 2005, a first office action was mailed. In this action, claims 6 and 8-33 were deemed withdrawn and the remaining claims (1-5 and 7) were rejected. In addition, the restriction requirement and election of species requirement were made final, and a replacement Figure 1 was required that included subject matter of claim 4 (which depended from independent claim 1).

D. On March 14, 2006, Applicant filed a reply to the office action mailed December 27, 2005. In this reply, Applicant further traversed the restriction requirement and election of species requirement and protested the withdrawal of claims believed to read on the elected invention and specie. In the interest of advancing prosecution, Applicant acquiesced to the request for a replacement Figure 1, and also incorporated subject matter of claim 4 into claim 1 and cancelled claim 4.

E. On June 7, 2006, a second office action was issued. Claims 1-3 were rejected, while the remaining claims were deemed withdrawn or cancelled.

F. On August 11, 2006, Applicant filed a reply to the June 7, 2006 office action. In further interest of focusing prosecution on claims the Examiner deemed to read on Invention I and Specie I, claims 8-33 were cancelled without prejudice against their re-assertion, and new

claims 34-42 were added to correspond to Figure 1. Claims 5-7 were amended to correctly depend from claim 1 vice cancelled claim 4.

G. On November 11, 2006, a Final office action was issued in which claims 1-3 and 5-7 were rejected, and new claims 34-42 were deemed withdrawn without being examined.

## **II ISSUES**

### **A. The Restriction Requirement was Unwarranted or Incorrectly Applied**

As asserted in Applicant's Reply filed October 7, 2005, interpretation of the claims of Inventions I and II as being directed to a process of making and a product made (MPEP § 806.05(f)) was incorrect. In particular, the method claims of the application (claims 27-33) are not directed to a process of making the product(s) encompassed by the apparatus claims (claims 1-26). The preamble ("A method of ensuring the disablement of an electronic assembly") and the claim limitations (e.g., "receiving an electronic assembly", "detaching said key from the electronic assembly") makes this evident.

If subject to restriction at all, the claims of the application are more accurately characterized as being related as a process and apparatus for its practice (MPEP § 806.05(e)) or, alternatively, as a product and a process of using (MPEP § 806.05(h)). However, with regard to MPEP § 806.05(e), Applicant asserts that application of the claimed process requires an apparatus substantially similar to the claimed apparatus(es) – e.g., an apparatus having a provably detachable portion – and that the claimed apparatus(es) is/are most suitable for use with a process substantially similar to the claimed process. With regard to MPEP § 806.05(h), Applicant asserts that application of the claimed process of using requires a product substantially similar to the claimed product(s), and that the claimed product(s) is/are most suitable for use with a process substantially similar to the claimed process.

### **B. The Election of Species Requirement was Unwarranted or Incorrectly Applied**

As asserted in Applicant's Reply filed October 7, 2005, the requirement to elect one of four species was unwarranted.

1. *The Original Claims of the Application Include a Generic Claim*

Original claim 17 is a generic claim that reads on each of the four species identified by the Examiner. In particular, claim 17 is believed to read on each of Figures 1 – 4. Claim 17 requires no material element additional to other independent apparatus claims of the application, and each such independent claim requires all the limitations of claim 17 (MPEP § 806.04(d)).

In particular, in embodiments of the invention disclosed in the present application, the “portion of an electronic assembly ...” and “signal conduit ...” that are recited in claim 17 may correspond to: key 104 and trace 106 of Figure 1, key 204 and trace(s) 212 of Figure 2, key 304 and trace 308a of Figure 3, and key 404 and trace 408 of Figure 4.

The recitation that “the electronic assembly is operable while said portion is attached to the assembly” is reflected in the continuous nature of trace 106 (Figure 1), trace(s) 212 (Figure 2), trace 308a (Figure 3) and trace 408 (Figure 4) as they extend to and from the key portions. More specifically, as long as the portion is attached to the assembly, the traces can carry some type of electrical signal or power.

The recitation that “one or more functions of the assembly become inoperable when said portion is detached from the assembly” reads on each figure, in that the detachment of key 104 (Figure 1), key 204 (Figure 2), key 304 (Figure 3) or key 404 (Figure 4) will result in the corresponding trace being severed, thereby rendering the trace incapable of carrying an electrical signal or power.

As specified in MPEP § 806.04, a generic claim may link a reasonable number of species. Applicant asserts that even if the application discloses four species, four is a reasonable number of species.

2. *Requiring Restriction between Four Asserted Species was Improper*

MPEP § 806.04(f) requires species to be mutually exclusive in order for restriction to a single species to be proper. Applicant asserts that not all four asserted species are mutually exclusive. In particular, Species I – IV are associated with Figures 1 – 4, respectively, but the scope of *original* Figure 1 (prior to the alteration required by the Examiner) significantly overlaps the scope of Figures 3 and 4. Further, the scope of

*replacement* Figure 1 overlaps the scope of Figure 2.

C. Claims were Withdrawn in the First Office Action that Should not have Been

In Applicant's Reply filed October 7, 2005, the restriction requirement and election of species requirement were traversed, but Invention 1 (claims 1-26) and Specie I (Figure 1) were provisionally elected. In the first office action, mailed December 27, 2005, the Examiner withdrew claims 8-26 (in addition to non-elected claims 27-33), stating that they did not read on Specie I. Claims 8-26 include 2 independent claims – claims 8 and 17.

1. *Claim 8*

Every limitation of claim 8 is included in the original Figure 1 and/or the replacement Figure 1. In particular, in an embodiment of the invention, the "segment of the electronic assembly ..." limitation may correspond to key 104, "one or more signal conductors ..." may correspond to trace 106, and "an identification" may correspond to identification 110. Thus, regardless of whether claim 8 read on Figure 1 as filed, it reads on the replacement Figure 1 now and should have been examined by the Examiner, at least after Applicant modified Figure 1 as required by the Examiner. Applicant thus requests claims 8 – 16 be reinstated and examined.

2. *Claims 9-16*

Before and/or after replacement Figure 1 was filed, some or all of dependent claims 9-16 also read on Figure 1. For example, the specification describes many forms of "an identification" or "identification module", thereby enabling at least claims 9, 11 and 12 to read on Figure 1. In addition, Figure 1 portrays "gaps" as recited in claim 13, and the external circuit board edge recited in claims 14 and 15.

3. *Claim 17*

As stated above, Applicant asserts that claim 17 is a generic claim that reads on all identified species. For example, in an embodiment of the invention, "a portion of an electronic assembly ..." may correspond to key 104, while "a signal conduit ..." may

correspond to trace 106. As described above in section II.B.1 of this Petition, claim 17 also reads on Figures 2 – 4. Applicant thus requests claims 17 – 26 be reinstated and examined.

4. *Claims 17-26*

Before and/or after replacement Figure 1 was filed, some or all of dependent claims 17 – 26 also read on Figure 1. For example, the specification describes many forms of “an identification” or “identification module”, thereby enabling at least claims 18 – 23 to read on Figure 1. In addition, Figure 1 can be interpreted as reflecting the coplanar status recited in claim 24 and the “gaps” recited in claim 25.

D. Claims 34-42 should have been Examined

In Applicant’s Reply of August 11, 2006, filed in response to the second office action, new claims 34 – 42 were presented. These claims were drafted with the intention of covering the embodiment/specie of the invention depicted in Figure 1. However, in the following final office action, the claims were deemed withdrawn and described as not reading on Figure 1.

Because claims 34 – 42 read on Figure 1, Applicant requests they be examined.

E. Claims were Cancelled in the Interest of Prosecution, but Should be Reinstated

Claims 8 – 26 were cancelled (without prejudice) only after the restriction requirement and election of species requirement were made final. They were cancelled in the hope that other worthy claims would be fully examined without the distraction of claims that were rightly or wrongly deemed withdrawn. Because it appears that even claims written directly to Figure 1 (e.g., claims 34 – 42) will not be examined, Applicant requests claims 8 – 26 be reinstated and examined along with claims 34 – 42.

### III CONCLUSION

Applicant requests the re-commencement of examination of this application with the original claims and Figures, and requests that the restriction requirement and election of species requirement be withdrawn or amended as described above.

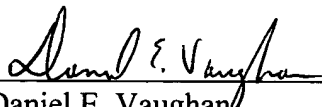


In the event the restriction requirement and/or election of species requirement are upheld, with or without modification, Applicant requests claim 17 be treated and examined as a generic claim. Applicant further requests the recognition and examination of claims 34-42 as reading on the elected invention and specie.

Further, if re-commencement of examination of the application is denied, Applicant requests in the alternative that the final office action dated November 14, 2006 be withdrawn and that the Request for Continued Examination that accompanies this Petition be cancelled.

Respectfully submitted,

Dated: February 8, 2007

By:  42,199  
Daniel E. Vaughan (Registration No.)

Park, Vaughan & Fleming LLP  
P.O. Box 7865  
Fremont, CA 94537  
(510) 790-9960 voice  
(510) 790-9964 facsimile